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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/494,743	01/31/2000	James W. Peel JR.	FE-00427	3854
30743	7590	04/23/2004	EXAMINER	
WHITHAM, CURTIS & CHRISTOFFERSON, P.C. 11491 SUNSET HILLS ROAD SUITE 340 RESTON, VA 20190			HUYNH, CONG LAC T	
			ART UNIT	PAPER NUMBER
			2178	
DATE MAILED: 04/23/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/494,743	PEEL ET AL.	
	Examiner Cong-Lac Huynh	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 03 February 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-24 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 17 February 2004 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

1. This action is responsive to communications: amendment filed 2/3/04 to application filed on 1/31/00, priority 6/14/99.
2. Claims 1-24 are pending in the case. Claims 1, 14, 16-17, 20, 23-24 are independent claims.
3. The objections of claims 20-22 as including informalities have been withdrawn in view of the amendment.
4. The rejections of claims 16-19 under 35 USC 112, second paragraph, as failing to set forth the subject matter which applicants regard as their invention remain since though the claim 16 is amended, the amended claim still has an incorrect element.
5. The rejections of claims 1-9, 14-15, 23-24 under 35 U.S.C. 103(a) as being unpatentable over Fleskes have been withdrawn in view of applicants' arguments.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
7. Claims 16-19 remain rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that claims 16-19 fail(s) to correspond in scope with that which applicant(s) regard as the invention can be found in Paper No. 1 filed 1/31/00.

Applicants amended independent claim 16 by replacing step (a) with step (b) in the limitation (e) (3) (lines 21-22), which is correct. However, still in said limitation (e)

(3), step (f) in the limitation “recursively performing steps (b) to (f) for said exited-to procedure”, as pointed out in the previous office action but is not amended, is not correct. Since when step (e) (3) is performed, *step (f) is not performed yet*, it is not reasonable how to *recursively perform steps (b) to (f)* in step (e) (3).

Independent 17 has the same issue as in claim 16.

Dependent claims 18-19 are objected to for fully incorporating the deficiencies of their base claim 17.

8. Claims 1-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 (line 14), claim 11 (line 3), claim 13 (line 4), claim 14 (lines 7, 12), claim 16 (lines 9-19, 18), claim 17 (lines 10-11, 19), claim 20 (line 12), claim 23 (line 16), claim 24 (line 17) recite “said DBMS” where DBMS is the abbreviation of Database Management System (specification, page 2, line 27). There is insufficient antecedent basis for this term in these claims.

Dependent claims 2-13, 15, 18-19, 21-22 are rejected for fully incorporating the deficiencies of their base claims 1, 14, 17 and 20.

Regarding claim 7, it is unclear to send an email or to send the web page update to a user in the limitation “sending *email web page updates* to a user, said user overwriting existing web pages with said web page updates” (lines 2-4).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 1-5, 8-9, 14-15, 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimizu et al. (US Pat No. 6,374,271 B1, 4/16/02, filed 9/26/97) in view of Mueller (US Pat No. 6,694,484 B1, 2/17/04, filed 6/3/97).

Regarding independent claim 1, Shimizu discloses:

- connecting to a database structure having data having a hierarchy and defining an electronic media description (figures 1, 2, 4, 8, col 1, lines 51-65, col 3, lines 30-45: link to a card database of media such as video, audio, text ...where media in the

database has a hierarchy structure in folders as in figures 8, 12 and has media such as video, audio, image...)

- generating a top level menu of structures from said electronic media description (figure 12)
- selecting, from said menu, a structure to parse and parsing said selected structure (figures 12-14: the folder card of the media can be selected when highlighted suggests the structure of the media included in the card)
- generating a *hypermedia document* that preserve said hierarchy of said original electronic media description in a structure database (col 1, line 43 to col 2, line 19: a hypermedia authoring system to generate a document using a goal outline and the presentation outline where the *information content of the document contained in cards in the card database in a logical structure* where the card database is a multimedia database and the media in a Bento-box is *hyperlinked* to another Bento-box)

Shimizu does not explicitly disclose that the web pages generated are tagged data relative web pages.

Mueller discloses associating HTML tags to multimedia data, for example an image, video segment, animation, or audio file stored in a local database, in generating a web page (col 1, lines 32-51, col 2, lines 40-67, figure 2).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Mueller into Shimizu for the following reason. Mueller discloses generating media information associated with a HTML document by

embedding HTML tags to the media data such as image, video, audio stored in a local database providing the advantage to apply associating HTML tags to media data selected from the card database as in Shimizu for generating hypermedia documents since the card database in Shimizu is a form of a local database in Mueller. The combination of Mueller into Shimizu with the media data for generating a document stored in a database would eliminate the need of having to transmit the stored data with the HTML document and thus reducing the transmission overhead.

Regarding claim 2, which is dependent on claim 1, Shimizu discloses that the hierarchy is preserved by generating links between and among said tagged data relative web pages which correspond to said original hierarchy of said original electronic media description (col 2, lines 1-19: generating links between the Bento-boxes of media data of a hypermedia document, which is a hypertext document or a web page).

Regarding claim 3, which is dependent on claim 1, Shimizu discloses selecting interoperability options (col 2, lines 28-39: select the bento-boxes presentation outline via highlighting corresponding nodes in the goal outline).

Regarding claim 4, which is dependent on claim 1, Shimizu discloses converting graphics files to a format selected in the step of selecting interoperability options, wherein a user may choose to convert only graphics files actually referenced in said selected menu structure (figures 12 and 13, col 7, lines 26-45: user can select either

caption, video, image in the hierarchy, and the image file in *the related card* is highlighted).

Regarding claim 5, which is dependent on claim 1, Shimizu discloses displaying the status of generating tagged data relative web pages in real time (col 8, lines 56-65: an indicator is shown to show the almost completeness of the hypermedia document).

Regarding claim 8, which is dependent on claim 1, Shimizu does not explicitly disclose displaying said tagged data relative web pages using a web browser.

Mueller discloses displaying said tagged data relative web pages using a web browser (col 1, lines 44-46).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Mueller into Shimizu for displaying a tagged data relative web pages using a web browser.

Regarding claim 9, which is dependent on claim 1, Shimizu does not explicitly disclose that said tagged data relative web pages are coded in one of the languages selected from the group consisting of Standard Generalized Markup Language (SGML), extensible Markup Language (XML) and Hypertext Markup Language (HTML).

Mueller discloses the generated web pages are coded in Hypertext Markup Language (HTML) (figure 2, col 2, line 40 to col 3, line 24).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Mueller into Shimizu to show evidence that the tagged relative web pages are coded in a markup up language such as HTML, one of the markup languages selected in the group of SGML, XML, and HTML.

Claims 14-15 are for an apparatus of claim 1, and are rejected under the same rationale.

Claims 23-24 are for a computer data signal embodied in a carrier wave and a digital data stream of method claim 1, and are rejected under the same rationale.

12. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimizu in view of Mueller as applied to claim 1 above, and further in view of Davis et al. (US Pat No. 5,937,160, 8/10/99, filed 5/10/97).

Regarding claim 6, which is dependent on claim 1, Shimizu and Mueller do not disclose exporting said relative web pages to be used in a standalone environment. Davis discloses exporting said relative web pages to be used in a standalone environment (figure 4, #100: generating and *transmitting web page revision* to a web server via email).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Davis into Shimizu and Mueller since transmitting a web

page revision, which is actually a web page updated *to a server*, suggests exporting the web page to a standalone environment since the server is considered equivalent to a standalone environment compared with the client and transmitting a web page is a form of sending out a web page to another terminal.

Regarding claim 7, which is dependent on claim 1, Shimizu and Mueller do not disclose that the step of exporting is performed by sending email web page updates to a user, said user overwriting existing web pages with said web page updates.

Davis discloses sending web page updates via email to a user, said user overwriting existing web pages with said web page updates (figures 4-5, #100, #200, #300, #104, #106, figure 9B, #300).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Davis into Shimizu and Mueller to provide a way to notify users the update version of the web pages whenever any change is made to the web pages.

Allowable Subject Matter

13. Claims 10-13 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

14. Claims 16-22 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Response to Arguments

15. Applicant's arguments with respect to claims 1-9, 14-15, 23-24 have been considered but are moot in view of the new ground(s) of rejection.

Applicants argue that Fleske does not disclose extracting a portion of a hierarchical data structure of media from a media database while preserving that hierarchy and the internal cross-reference when wrapping HTML or the like to the specific data elements to make them accessible as web pages (Remarks, page 15).

Examiner agrees.

Fleske is withdrawn from the claim rejections.

Shimizu and Mueller disclose the argued feature, as mentioned in the rejections above.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Newman et al. (US Pat No. 5,983,245, 11/9/99, filed 12/27/96).

Wesemann et al. (US Pat No. 6,349,132 B1, 2/19/02, filed 12/16/99).

Burg et al. (US Pat No. 6,456,699 B1, 9/24/02, filed 11/30/98).

Tinkler (US Pat No. 6,411,999 B1, 6/25/02, filed 10/8/98).

Papierniak et al. (US Pat No. 6,714,931 B1, 3/30/04, filed 4/29/98).

Shipman III et al., Generating web-based presentations in spatial hypertext, ACM 1997, pages 71-78.

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Dennis et al., Technical issues in hypermedia authoring systems extended abstract, IEEE 1996, pages 373-378.

Hand, Creating hypermedia documents by doing an alternative to authoring, IEEE 1995, pages 1-3.

Ginige et al., Hypermedia authoring, IEEE 1995, pages 24-35.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 703-305-0432. The examiner can normally be reached on Mon-Fri (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 703-308-5186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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4/18/04



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PRIMARY EXAMINER